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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,749	12/18/2000	Sue-Ken Yap	169.1912	1352

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EXAMINER

CAPUTO, LISA M

ART UNIT PAPER NUMBER

2876

DATE MAILED: 10/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/737,749

Applicant(s)

YAP, SUE-KEN

Examiner

Lisa M Caputo

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Amendment***

1. Receipt is acknowledged of the preliminary amendment filed 19 August 2002.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Reference numbers 1502, 1614, and 510 are not mentioned in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities:  
Regarding abstract, page 37, line 12: Replace "icons(122)" with --icons (122)--.  
Regarding page 9, line 17: Replace "Figure 4" with --Figure 9--.  
Regarding page 9, line 24: Replace "Figure 5" with --Figure 4--.  
Regarding page 10, line 8: Replace "Figure 6" with --Figure 10--.  
Regarding page 10, line 23: Replace "Figure 7" with --Figure 11--.  
Regarding page 11, line 17: Replace "Figure 8" with --Figure 13--.  
Regarding page 11, line 20: Replace "Figure 5" with --Figure 4--.  
Regarding page 12, line 14: Replace "Figure 9" with --Figure 14--.

Regarding page 13, line 7: Replace "Figure 10" with --Figure 12--.

Regarding page 14, line 4: Replace "Figure 11" with --Figure 6--.

Regarding page 16, line 12: Replace "Figure 12" with --Figure 15--.

Regarding page 16, line 15: Replace "Figure 13" with --Figure 16--.

Regarding page 17, line 13: Replace "Figure 14" with --Figure 17--.

Regarding page 19, line 9: Replace "Figure 16" with --Figure 8--.

Regarding page 19, line 12: Replace "Figure 17" with --Figure 7--.

Regarding page 20, line 23: Replace "Figure 15" with --Figure 5--.

Examiner intimated these Figure number changes since the reference numbers within the paragraph matched those of the new Figure number given, rather than that of the Figure number stated.

Regarding page 9, line 24, page 11, line 20, and wherever else it occurs:

Replace "dialler" with --dialer--.

Regarding page 14, line 1: Replace "anther" with --another--.

Regarding page 17, line 25: Replace "1710as" with --1710 as--.

Regarding page 9, line 4: Clarify that reference numbers 120-128 referenced are even numbers only (i.e. 120, 122, 124...).

Regarding page 9, line 7: Clarify that reference numbers 114-128 referenced are even numbers only (i.e. 114, 116, 118...).

Regarding page 9, line 26: Replace "401 to 405" with --403 to 407-- and clarify that reference numbers 403-407 referenced are odd numbers only (i.e. 403, 405, 407).

Regarding page 10, line 3: Replace "401 to 405" with --403 to 407-- and clarify that reference numbers 403-407 referenced are odd numbers only (i.e. 403, 405, 407).

Appropriate correction is required.

5. The use of the trademarks Microsoft and Hotmail have been noted in this application. They should be capitalized wherever they appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 is vague and indefinite as to which embodiments are being used.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 8-16, 23-26, 33-40, 43-46, 48, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Combaluzier (WO 95/35534).

Combaluzier teaches a control unit with a keypad connectable to a smart card for activating the unit and keypad having all of the elements as recited in claims 1, 8-16, 23-26, 33-40, 43-46, 48, and 50.

Combaluzier discloses a control unit (1) consisting of a touch-sensitive keypad (2), a display (8) and an operating system. Said unit (1) has a slot for a smart card (memory card) (3) used to activate the unit (1). The keypad (2) comprises a number of touch-sensitive keys (13) made of transparent material so that the underlying inserted smart card (3) is visible. The back surface of the smart card (3) contacting the keypad (2) includes a set of customized indicia (14) each corresponding to one touch-sensitive key (13) on the keypad (2), and each of the smart card indicia (14) that can be seen through the transparent keys (13) of the keypad (2) represents the function assigned to the corresponding key (13) by the smart card (3) so that the unit (1) can be used in a variety of settings. Said unit is useful for remotely controlling electrical equipment and/or providing information to users (the data information can be entered and can include access and control information for external devices) (see abstract). Combaluzier teaches a control housing formed of a tactile keyboard, communication means, and operating means of the assembly, a housing being adapted to receive, in a recess provided for this purpose, a memory card which actuates said housing, characterized by the fact that the keyboard is comprised by a certain number of tactile keys which are of transparent material, leaving visible the sub-adjacent memory card which has been introduced, and by the fact that said memory card comprises, on its back, located in contact with the housing, an assembly of individualized datum, each datum corresponding to one of the tactile keys of the keyboard, and in that each datum, carried by the memory card and visible through each key of the keyboard, is representative of the function attributed to each corresponding key by said memory card, which actuates the housing in different fields (link associated with indicia with switches in order to access desired function) (see page 4, lines 9-21). In addition, Combaluzier teaches that

the housing 1 (reader device) is constituted on its upper surface by a tactile keyboard 2 (operable switches), having the essential property that it is transparent. The memory card 3 (smartcard) comprises data 14 on its back and a chip 18. These data can be constituted by directional symbols or ideagrams as seen in Figure 6, and also by numerals and letters and shown in Figure 7 (multiple indicia formed on the surface of the smartcard as recited in claim 1 of the instant application). Each datum 14 carried by the memory card 3 is visible through the transparency of each key 13 of the keyboard 2 and is representative of the function attributed to each corresponding key 13 carried by said memory card 3. The memory card 3, by means of its chip 18, programs the housing 1 via a connector 4 of the card 3 and an interface 5 of the card 3 directly connected to a microprocessor 9, as shown in Figure 9 (see Figures 1-7, page 6 line 14 to page 7 line 25).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3, 17-18, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier (WO 95/35534) in view of Nemirofsky et al. (U.S. Patent No. 5,880,769, from hereinafter "Nemirofsky"). The teachings of Combaluzier have been discussed above.

Regarding claims 2-3, 17-18, and 27-28 Combaluzier fails to teach a transceiver apparatus.

Nemirofsky teaches an interactive smart card system for integrating the provision of remote and local services. Nemirofsky discloses that FIG. 4 is a block diagram of the electronics disposed within the smart card 10. Data from external sources is converted into digital data. Thus, as illustrated, a modem 42 and the ISO 7816 interface 26 are coupled to a multiplexer 46, which provides serial data to a universal asynchronous receiver-transmitter (UART) 47. In a preferred embodiment, the modem 42 is compatible with a standard modem protocol such as Bell 300, and supports auto-dial. The UART 47 in turn provides parallel data to a bus 72, which is coupled to a central processing unit (CPU) 48 and a static random access memory 52. A VEIL receiver 40 that is coupled to the bus 72. A transceiver 74 coupled to the bus 72 converts electromagnetic waves of lower frequency than visible light received over antenna 76 into digital data (see Figure 4, col 3, lines 25-39).

In view of the teaching of Nemirofsky, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a transceiver to receive and analyze data because a transceiver is well known in the art to provide efficient communication between two entities sharing information. It is favorable for analyzing the output signal because the transceiver will be able to efficiently transfer information and help to make a decision about the choice of selection of the user.

9. Claims 4-7, 19-22, 29-32, 41-42, 47, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier (WO 95/35534) in view of Rouyrre et al. (U.S. Patent No. 5,880,769, from hereinafter "Rouyrre"). The teachings of Combaluzier have been discussed above.

Combaluzier fails to teach that another output signal is requested when the contextual information doesn't match.



Rouyee teaches a smart tool for communication and an appliance making use thereof. Rouyee discloses that the function of the logic stage 110 is to produce a positive acknowledge message MAP or a negative acknowledge message MAN in response to correct frame signals STC or incorrect frame signals STI produced by the reception module 126. The acknowledge messages produced in this way are applied to the logic stage 108 which transforms them into formatted frames. Logic stage 107 is a transmit buffer memory associated with logic stage 108 for the purpose of temporarily storing the most recently transmitted frame. Retransmission logic stage 109 is connected to stage 107 and is adapted to apply the frame stored in the buffer memory 107 to the input stage 104 of the transmitter member 14 in response to a retransmit request signal DRT produced either by the reception module 126 or else by a timing stage 111. The stage 111 produces a DRT signal when the time interval between two successive frames exceeds a determined duration, meaning that there has been an instantaneous interruption in the both-way link established between two coupled-together cards (see Figures 6a-6b, 7, col 9, lines 34-52).

In view of the teaching of Rouyre, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ means to generate another output signal so as to ensure that the correct function is selected. This is favorable because it will expedite the selection of a function if the original signal is not processed correctly.

### **Conclusion**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(703) 308-8505**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-

Art Unit: 2876

3503. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[lisa.caputo@uspto.gov]**.


*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



LMC

October 20, 2002

  
MICHAEL G. LEE  
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